

REMARKS

Please reconsider the application in view of the above amendments and the following remarks. Applicant thanks the Examiner for carefully considering this application.

Disposition of Claims

Claims 1-10 are pending in this application. Claims 1 and 10 are independent. The remaining claims depend, directly or indirectly, from claim 1.

Drawings

The Applicant respectfully requests that the Examiner indicate whether the drawings filed with the referenced application are acceptable.

Claim Amendments

Independent claims 1 and 10 have been amended to clarify that the invention is directed to an integrated circuit *portable* device (*e.g.*, a smart card). Support for the aforementioned amendments, may be found, for example, on p. 1, ll. 14-22 and Figure 1 of the instant specification. The Applicant respectfully asserts that no new matter has been by these amendments.

Rejection(s) under 35 U.S.C § 103

Claims 1-3, 7, and 10 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Admitted Prior Art (APA) in view of U.S. Patent No. 6,754,670 ("Lindsay"). To the extent that this rejection still applies to the amended claims, this rejection is respectfully traversed.

Independent claim 1 relates to an integrated circuit portable device (*e.g.*, a smart card) that includes a limited amount of memory, where an application program and an initializing means reside within the memory. As recited, claim 1 is directed to an integrated circuit portable device that enables the application program to be configured without using a configuration file stored in memory. Instead, as recited in claim 1, a command and the initialization means is used to configure variables associated with the application program in the application program itself. Therefore, the duplication of configuration data in memory when configuring the application program is unnecessary and can be avoided. The aforementioned reduction in memory usage is especially important because limited memory exists on the integrated circuit portable device. (*See, e.g.*, Instant Specification, p.2, ll. 13-23 and p.4, l.1 - p.5, l. 30).

In contrast to the claimed invention, APA discloses files containing data (*i.e.*, initialization values) assigned to variables which are stored in memory (*see, e.g.*, Instant Specification, page 1, ll. 23-25). However, as admitted by the Examiner, the APA does not teach or suggest initializing configuration variables within an application program without the use of files residing in memory. Further, the Applicant respectfully asserts that the APA does not disclose or suggest the configuration of an application program by transferring a value provided in a command to configuration variables. Moreover, the Applicant respectfully asserts that Lindsay may not be relied upon to teach that which the APA lacks, as Lindsay is nonanalogous art.

As stated in MPEP §2141.01(a), all prior art relied upon by the Examiner in maintaining a 35 U.S.C. §103 rejection must be analogous art. Prior art is considered to analogous, if the prior art is in the field of the applicant's endeavor or is reasonably pertinent to the particular problem with which the invention is concerned. *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). Lindsay does not qualify as analogous art under either of the

aforementioned categories. Specifically, Lindsay is not in the applicant's field of endeavor, as Lindsay is directed to a maintaining a mapping for a relational database (*See, e.g., Lindsay*, col. 1, ll. 23-29 and col. 2, ll. 9-13), while the claimed invention is directed towards configuring various variables used by an application residing on an integrated circuit portable device (*e.g., a smart card*).

Moreover, Lindsay is not relevant to the problem with which the invention is directed to solving. In particular, the claimed invention is directed to method and apparatus for programming an integrated circuit portable device without having to maintain duplicate data on the integrated circuit portable device. (*See Instant Specification*, p. 2, ll. 13-24). In contrast, Lindsay is directed to maintaining an *external* mapping to the relational database which allows applications, *external* to the relational database, to access data stored in the relational database. (*See Lindsay*, col. 1, ll. 23-29 and col. 2, ll. 9-13). Thus, the teachings of Lindsay are directed to the execution of *external* applications on systems that have ample memory space (*i.e., systems that do not include the same memory limitations as the integrated circuit portable devices recited in the claims*) and allow the system to maintain an *external* mapping. Thus, because Lindsay requires significant memory resources, the teaching of Lindsay is actually inapplicable to the technical field of the claimed invention. Said another way, one skilled in the art would not look to Lindsay to solve the problem the claimed invention solves. In view of the above, Lindsay is nonanalogous art and, thus, may not be used to maintain a rejection under 35 U.S.C. §103. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 4 and 5 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Admitted Prior Art (APA) in view of Lindsay and further in view of U.S. Patent No. 5,829,006 ("Parvathaneny"). Claims 4 and 5 depend from amended independent claim 1. To the extent that this rejection still applies to the amended claims, this rejection is respectfully traversed.

The Examiner has admitted that the APA does not teach or suggest all the limitations recited in amended independent claim 1. Moreover, as discussed above, Lindsay is nonanalogous art and, thus, may not be relied upon to teach that which Lindsay lacks. Further, the Applicant respectfully asserts that Parvathaneny does not teach or suggest all the limitations recited in independent claim 1 as well as dependent claims 4 and 5, for the reasons as previously discussed in the Response to Office Action mailed July 12, 2004 and incorporated herein by reference. In view of the above, the rejection under 35 U.S.C. §103 cannot be maintained. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 6 and 8 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Admitted Prior Art (APA) in view of Lindsay and further in view of U.S. Patent No. 6,708,181 ("Peterson"). Claim 6 depends from amended independent claim 1. To the extent that this rejection still applies to the amended claims, this rejection is respectfully traversed.

The Examiner has admitted that the APA does not teach or suggest all the limitations recited in amended independent claim 1. Moreover, as discussed above, Lindsay is nonanalogous art and, thus, may not be relied upon to teach that which the APA lacks. Moreover, Peterson does not teach that which the APA and Lindsay lack. This is evidenced by the fact that Peterson is only relied upon to teach "class initialization" methods. In view of the above, the rejection under 35 U.S.C. §103 cannot be maintained. Accordingly, withdrawal of this rejection is respectfully requested.

Claim 9 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Admitted Prior Art (APA) in view of Lindsay and further in view of U.S. Patent No. 6,110,227 ("Marcelais"). Claim 9 depends from amended independent claim 1. To the extent that this rejection still applies to the amended claims, this rejection is respectfully traversed.

The Examiner has admitted that APA does not teach or suggest all the limitations recited in amended independent claim 1. Moreover, as discussed above, Lindsay is nonanalogous art and, thus, may not be relied upon to teach that which the APA lacks. Moreover, Marcelais does not teach that which the APA and Lindsay lack. This is evidenced by the fact that Marcelais is only relied upon to teach a "command enabling reading." In view of the above, the rejection under 35 U.S.C. §103 cannot be maintained. Accordingly, withdrawal of this rejection is respectfully requested.

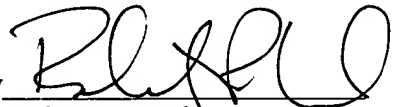
Conclusion

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 09669.003001).

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Respectfully submitted,

By



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